

REMARKS

This is in response to the office action dated May 23, 2005.

Drawing Fig. 7 has been corrected as instructed by the Patent Examiner in paragraph 1 of the office action.

A substitute specification is submitted herewith along with a marked-up copy of the original specification as instructed by the Patent Examiner in paragraph 2 of the office action. The reference numerals have not been removed as it is believed that they are proper and that no basis exists for their exclusion. A listing of reference numerals is helpful in the reading of the application.

The subject matter of claims 1 and 2 has been rewritten and presented as new claims 3 and 4 in response to the rejection under 35 USC 112, second paragraph, as set forth in paragraphs 3 and 4 of the office action. It is believed that the new claims are written so as to avoid the rejection under 35 USC 112, second paragraph.

Claim 1 was rejected under 35 USC 102 (b) as being anticipated by Nakamura et al (US 5,913,742). As previously indicated, the subject matter of claim 1 has been rewritten as new claim 3.

The Patent Examiner states that "Nakamura et al discloses a body of said tensioner is composed of outer (2) and inner (21, 23) bodies of different members." The Examiner's identifications are incorrect. First, the outer body is denoted by reference numeral 21 and the inner body is denoted by reference numeral 30. The Examiner further

states that the “outer body is provided with a tensioner mounting means (unnumbered flanges, see Fig. 2).” However, an inspection of the ‘742 patent does not reveal any mounting means as set forth in Fig. 1. Fig. 2 is just an enlargement of Fig. 1 and Figs. 1 or 2 do not show the outer body 21 (housing) affixed to the cylinder head 2. Col. 3, lns. 23 et seq. Surely there must be some mounting means but we do not know what they are. A rejection under section 102 requires some identification of structure to meet each element and limitation of the claim and here there is none.

The Examiner further states that Nakamura includes an inner body fitting hole (2 sub. 1), however, Nakamura describes 2 sub. 1 as a mounting bore through a wall surface of the cylinder head, not a fitting hole in the outer body. Nakamura also identifies the inner body as including a plunger accommodating hole (27) into which a plunger biased by a compression spring 38 was slidably fitted. The plunger accommodating hole in Nakamura is 33, not 27 and the compression spring is identified by reference numeral 38, not 31.

Claim 3 recites 3 a plunger which includes an outer circumference and the outer circumference of said plunger includes a rack. The plunger in Nakamura is item 34 and it does not have a rack on its circumference. Rather, the rack in Nakamura appears to be on the circumference of the inner body 30. Further, claim 3 requires that the inner body be press-fitted into the inner body fitting hole of the outer body. Nakamura, however, provides for relative motion between the inner body 30 and the outer body 21 as further

evidenced by spring 31 and seal 29.

Claim 3 is believed to be patentable over Nakamura based on section 102.

Claim 4 is believed to patentable as dependent on allowable claim 3.

A terminal disclaimer is being submitted herewith in regard to serial no.

10/679,644 despite the fact that it is not believed that serial no. 10/679,644 qualifies as a reference. Patents issuing on the instant application and on serial no. 10/679,644 are coterminous and are commonly owned and will remain to be commonly owned.

A terminal disclaimer is not being submitted in regard to serial no. 10/914,452 because that application was filed **after** the instant application and has a Japanese priority date **after** the filing date of the instant application. It is believed that a terminal disclaimer may be required in serial no. 10/914,452 but not in the instant application because if anything any term of any patent issued on serial no. 10/914,452 will extend beyond the instant application. It is not believed that the serial no. 10/914,452 application is a "reference".

Applicant wishes to advise the Examiner of serial no. 10/454,860 filed June 5, 2003 and which is co-pending and owned by Tsubakimoto Chain Co.

Respectfully submitted,

WOODLING, KROST AND RUST

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440-256-4150